



**MOSER PATTERSON & SHERIDAN
595 SHREWSBURY AVE, STE 100
FIRST FLOOR
SHREWSBURY, NJ 07702**

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AUG 26 2005

OFFICE OF PETITIONS

In re Application of
Luis Valente
Application No. 09/330,274
Filed: June 11, 1999
Attorney Docket No. LIEB0013

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 14, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." Petitioner is advised that this is **not** a final agency action decision.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 29, 2002, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 30, 2002. A Notice of Abandonment was mailed on December 16, 2003.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by:

- (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof;
- (2) the petition fee as set forth in 37 CFR 1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)).

The instant petition does not satisfy requirement (1) above.

The amendment filed on September 15, 2003 has been reviewed by examiner Paul Callahan. He determined that said amendment "canceling all claims drawn to the elected invention (election by original presentation) and presenting only claims drawn to a non-elected invention, is non-responsive (MPEP 821.03). The remaining claims are not readable on the elected invention...." Therefore, since the amendment does not constitute a proper reply under 37 CFR §1.137(b)(1) and this petition must be dismissed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (703) 872-9306
 ATTN: Office of Petitions

Pursuant to petitioner's authorization, Deposit Account No. 20-0782 was charged \$1,500.00 for the petition to revive an unintentionally abandoned application.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.


Wan Laymon

Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Date: 8-3-2005

From: Paul Callahan
Examiner, Art Unit 2137 Cryptography / Network Security
X-23869

To: Petitions Attorney / Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for Patent Examination Policy

Re: APPLICATION NO. 09/330,274, Amendment of 9-16-2003

The amendment filed 9/16/2003 canceling all claims drawn to the elected invention (election by original presentation) and presenting only claims drawn to a non-elected invention, is non-responsive (MPEP 821.03). The remaining claims are not readable on the elected invention because of the following reasons:

As per originally presented claim 1: the claim was directed towards a method, including the steps of sending a first certificate including security information regarding at least a second entity and including information authenticating a second certificate from a second entity; and sending said second certificate from said second entity; whereby a recipient of said first certificate and said second certificate can authenticate from information therein a first set of security information to associate with said first entity and a second set of security information to associate with said second entity.

The version of claim 1 presented in the amendment of 9-16-2003 is directed towards a method of securing an end user's computer system, and includes newly presented limitations not found in claim 1 as originally presented of:

- Storing a software provider's root security information object in the end user's computer system,

- Generating an end user's root security information object based on the software provider root security information object,
- Receiving security information from a higher level entity,
- Updating the end user's root security information object based on validated security information,
- Use of the end user root security information object to determine entities the end user can trust,
- The end user's computer system refuses information from an entity that is not included in the end user's root security information object.

Therefore the version of claim 1 presented in the 9-16-2003 amendment is directed towards a different invention than is originally present claim 1. The claims are distinct from one another as per MPEP Sec. 806.05c as subcombination (original claim 1) not essential to a combination (claim 1 as amended 9-16-2003). Here, the combination does not set forth the details of the subcombination of transmission of a first certificate, a second certificate, or information associated with the first certificate authenticating a second. The term "root security information object" as is used in the art of Cryptography, contemplates other objects in addition to digital certificates

The subcombination has a separate utility from the combination since the combination is directed towards storage of a software provider's root security information at an end user's computer, and is directed towards refusal to accept information by and end user where the information is being sent by a third party not listed in the software provider's root security information. The subcombination is not restricted to a software provider and end user as entities and is not

directed towards refusal of information. Therefore the subcombination has a utility by itself and is separately patentable.

The Amendment, received 9-16-03, was the second reply received in response to the Office Action mailed 12-20-02. The first reply was received 3-21-03 and was found to be non-responsive under MPEP 821.03 for the same reason as was the 9-16-2003 amendment. Therefore the second reply of 9-16-2003 must be considered as deliberately non-responsive.



Paul Callahan

Examiner Art Unit 2137

(571) 272-3869